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In re Application of:

KOHL, Paul, et al.

U.S. Application No.: 10/590,264

PCT No.: PCT/US2005/005088

International Filing Date: 16 February 2005

Priority Date: 19 February 2004

Attorney's Docket No.: 36157/1.9

For: MICROSTRUCTURES AND
METHODS OF FABRICATION
THEREOF

DECISION ON REQUEST UNDER
37 CFR 1.497(d)

This decision is issued in response to the "Request For Filing A Declaration Pursuant To 35 U.S.C. 371(c)(4) Naming An Inventive Entity Different From The Inventive Entity Set Forth In The International Stage Under 37 CFR 1.497(d)" filed 25 June 2007. Applicants have submitted the required processing and extension fees.

BACKGROUND

On 16 February 2005, applicants filed international application PCT/US2005/005088. The international application claimed a priority date of 19 February 2004, and it designated the United States. The deadline for submission of the basic national fee was thirty months from the priority date, i.e., 19 August 2006. The published international application identified a corporate applicant for all states other than the U.S., and four applicant/inventors for the U.S.: Paul KOHL, Christopher W. MOORE, Jun LI, and Justin TULLIS.

On 18 August 2006, applicants filed a Transmittal Letter for entry into the national stage in the United States accompanied by, among other materials, payment of the small entity basic national fee.

On 23 March 2007, the United States Designated/Elected Office (DO/EO/US) mailed a "Notification Of Missing Requirements" (Form PCT/DO/EO/905) indicating that an oath or declaration acceptable under 37 CFR 1.497 and the surcharge for filing the oath or declaration later than thirty months after the priority date were required.

On 25 June 2007, applicants filed a response to the Notification Of Missing Requirements (with one-month extension fee) that included the required surcharge payment, a declaration executed by three of the inventors listed on the international application (Paul

KOHL, Christopher W. MOORE, and Jun LI), and the request under 37 CFR 1.497(d) considered herein. The request under 37 CFR 1.497(d) seeks to delete Justin TULLIS as an inventor of record.

DISCUSSION

Where, as here, the filed declaration names an inventive entity different from that set forth in the international application, a grantable request under 37 CFR 1.497(d) is required. Such a request must include: (1) a statement from each person being added as an inventor and from each person being deleted as an inventor that any error in inventorship in the international application occurred without deceptive intent; (2) the processing fee; and (3) if an assignment has been executed by any of the original named inventors, the written consent of the consignee (in the form required by 37 CFR 3.73(b), and any new oath or declaration required by 37 CFR 1.497(f).

Applicant here has submitted the required statement from the inventor to be deleted, Justin TULLIS. Item (1) is therefore satisfied.

Applicant has also submitted the required processing fee. Item (2) is therefore satisfied.

Regarding item (3), applicant has not submitted the assent of the assignee to the change of inventorship. No assignment has been recorded herein, but the filing of the international application with a corporate applicant implies that such an assignee may exist. Before item (3) can be considered satisfied, applicant must submit a statement that no such assignee exists, or the written consent of the assignee if one does exist. Any such consent of the assignee must be accompanied by a proper statement under 37 CFR 3.73(b).

Item (4) does not apply to the present application.

Based on the above, applicants have failed to submit all the requirements of a grantable request to correct the inventive entity pursuant to 37 CFR 1.497(d).

In addition, the declaration filed 25 June 2007 is not in an acceptable form. Specifically, the declaration appears to be a compilation of three separately executed declarations, and as such is not acceptable under 37 CFR 1.497.¹ See MPEP § 201.03(II)(B): "Where individual declarations are executed, they must be submitted as individual declarations rather than combined into one declaration." Thus, applicants have failed to provide an acceptable oath or declaration in compliance with 37 CFR 1.497.

CONCLUSION

Applicant's request to correct inventorship under 37 CFR 1.497(d) is **DISMISSED** without prejudice.

¹ The compilation is evident in that the five-page declaration document consists of one page identified as "Page 1 of 3," one page identified as "Page 2 of 3," and three different copies of the signature page, identified as "Page 3 of 3."

The declaration filed 25 June 2007 is defective for failure to properly identify the inventors of record herein.

In addition, as noted above, the filed declaration also appears to be an unacceptable compilation of multiple declarations.

If reconsideration on the merits of the petition is desired, a proper response must be filed within **TWO (2) MONTHS** of the mail date of the present decision. Any request for reconsideration should include a cover letter entitled "Renewed Request Under 37 CFR 1.497(d)" and must include the materials required to satisfy item (3) of a grantable request, as discussed above (i.e., the consent of the assignee in the form required by 37 CFR 3.73(b) or a statement that no such assignee exists), as well as copies of the complete declarations executed by each of the inventors listed on the declaration (to resolve the compilation issue).

Failure to file a proper response will result in abandonment of the application. Extensions of time are available under 37 CFR 1.136(a)

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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